EA

# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/759,103 | 01/12/2001 | Scott Clark | 10567-003 | 1839 |

26158          7590          06/27/2005

WOMBLE CARLYLE SANDRIDGE & RICE, PLLC
P.O. BOX 7037
ATLANTA, GA  30357-0037

| EXAMINER |
|---|
| LASTRA, DANIEL |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3622 | |

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| | 09/759,103 | CLARK ET AL. |
| **Office Action Summary** | Examiner | Art Unit | |
| | DANIEL LASTRA | 3622 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on _30 March 2005_.

2a)☒ This action is **FINAL**.      2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) _1-30_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-30_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

1.    Claims 1-30 have been examined. Application 09/759,103 (SEARCH ENGINE

PROVIDING AN OPTION TO WIN THE ITEM SOUGHT) has a filing date 01/12/2001.

### *Response to Amendment*

2.    In response to Non Final Rejection filed 12/30/2004, the Applicant filed an

Amendment on 03/30/2005, which amended claims 1, 9, 10, 14, 15, 19, 21, 22, 26, 29

and 30. Applicant's amendment overcame the Section 112 rejection.

### *Claim Rejections - 35 USC § 103*

3.    The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 7-10, 12-15, 17-25 and 27 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Walker (US 2003/0054888) in view of Ghouri (US

2002/0082978).

As per claims 10 and 20-22, Walker teaches:

A method of providing a user with a game of chance, the method comprising:

receiving electronic signals representing at least one search parameter

descriptive of a product (see Walker paragraph 39);

transmitting electronic signals representing at a least one product, a price of the

product (see Walker paragraph 39). Walker does not expressly teach and a third-party

dealer of the product. However, Ghouri teaches a system that searches for dealers of

products selected by users (see paragraphs 22 and 23). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users' selected products, which users would like to play games to win said selected products. This feature would show to users the best dealers or manufacturers' offers of products selected by users.

*automatically* transmitting electronic signals representing at least a first option *for the user* to play a game to win the product without *the user* first making any payment (see Walker paragraph 130), *or requesting the first option* and a second option to purchase the product (see Walker paragraphs 34; 149);

if the user *chooses* to play the game:

electronically calculating a probability of winning the product *by the user*;

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see Walker paragraph 144); and

in response to a winning pseudo-random outcome, purchasing the product for the user (see Walker paragraph 145);

and

if the user chooses to purchase the product instead of playing the game:

directing the user to a web site which sells the product (see Walker paragraph 34,149-151);

As per claim 1, Walker teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals representing search parameters descriptive of a product or service (see Walker paragraph 39);

transmitting electronic signals representing dealers in the product or service and associated prices (see Walker figure 6). Walker does not expressly teach dealers. However, Ghouri teaches a system that searches for dealers of products selected by users (see paragraphs 22 and 23). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users' selected products, which users would like to play games to win said selected products. This feature would show to users the best dealers or manufacturers' offers of products selected by users.

*automatically* providing the user an option to play a game to win a selected product or service without the user first making any payment (see paragraph 130) *or requesting the option* (see paragraph 34; 149);

electronically calculating a probability of winning the selected product or service by the user (see paragraph 144);

electronically generating a pseudo-random outcome corresponding to the calculated probability of winning (see paragraph 145); and

in response to a winning pseudo-random outcome, purchasing the selected product or service for the user (see paragraph 145).

As per claim 15, Walker teaches:

A method of providing a user with a game of chance, the method comprising the steps of:

receiving electronic signals representing search parameters descriptive of a product (see Walker paragraph 39);

transmitting electronic signals representing a plurality of different dealers and associated prices charged by each of said different dealers for products identified in response to said at least one search paramater (see Walker figure 6). Walker does not expressly teach dealers. However, Ghouri teaches a system that searches for dealers of products selected by users (see paragraphs 22 and 23). Walker also teaches in figure 6, third party manufacturers of products (see "campbell's, Volvo, sony"). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would use the Ghouri system to display to users a list of different dealers or manufacturers of users' selected products, which users would like to play games to win said selected products. This feature would show to users the best dealers or manufacturers' offers of products selected by users.

*automatically* providing the user an option to play a game to win a selected product or service without the user first making any payment (see Walker paragraph 130) *or requesting the option* (see Walker paragraph 34; 149);

electronically calculating a probability of winning the selected product or service

by the user (see Walker paragraph 144);

electronically generating a pseudo-random outcome corresponding to the

calculated probability of winning (see Walker paragraph 145); and

in response to a winning pseudo-random outcome, purchasing said selected one

product from a corresponding dealer for the user (see paragraph 145).

As per claims 7, 12 and 17, Walker teaches:

The method of claim 10, comprising calculating a probability of winning based on

at least a current budget (see Walker paragraph 144).

As per claims 8, 13 and 18, Walker teaches:

The method of claim 10, comprising calculating a probability P of winning based

on a total number of game players (see Walker paragraph 110).

As per claim 23, Walker teaches:

The method for providing a user an opportunity to win a product or service of

claim 22 further comprising the step of purchasing the selected product or service for

the user if the outcome for the play of the game is a win (see Walker paragraphs 129-

131).

As per claim 25, the same rejection applied to claims 7-8 is applied to claim 25.

As per claims 2, 24 and 27, Walker teaches:

The method of claim 1, wherein the probability of winning on successive plays of

the game increases with the value derived from the user's interaction with the system

(see Walker paragraphs 26 and 89).

As per claims 9, 14 and 19, Walker teaches:

The method of claim 10, comprising calculating a probability P of winning based on:

$$P = \frac{P_a{}^*P_t{}^*P_m + P_u}{N}$$

where:

Walker does not expressly teach Pa is a probability factor that varies with the cost of the selected product in relation to the total cost of all products available. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that as the value of a prize approaches the total budget of a game of chance system, the more difficult would be the probability of winning a grand prize (see paragraph 143).

Pt is a probability factor that varies with a current prize budget (see Walker paragraph 118-119);

Pm is a probability factor that varies with a ratio of the current prize budget to a total amount of funds received (see Walker paragraph 118-119);

Pu is probability factor that varies with the user's behavior *during a user session* (see Walker paragraph 88); and

N is a number of current users (see Walker paragraph 110).

Claims 3-5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (U.S. 2003/0054888) in view of Ghouri (US 2002/0082978) and further in view Yoseloff (U.S. 6,331,143).

As per claims 3 and 29, Walker teaches:

The method of claim 1, wherein the pseudo-random outcome is indicated by displaying a user chosen number and a comparison number, such that a winning outcome is indicated by displaying a comparison number that matches the user-chosen number, and a losing outcome is indicated by displaying a comparison number that does not match the user-chosen number. However, Yoseloff teaches about a system where a player selects a number and the system generates a random number, and a winning outcome is indicated if the user-chosen number matches the system generated random number (see column 8, lines 35-50; column 7, lines 50-64; column 3, lines 35-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Walker system would allow customers to play a game where the user would choose a number and the system would generate a random number, and where the customer would win a prize when the user-chosen number matches the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games, without losing anything if the customer does not receive a winning outcome.

As per claim 4, Walker teaches:

The method of claim 3, wherein an increased probability of winning on successive plays of the game is indicated by displaying a comparison number having at least one digit matching the corresponding at least one digit of the user-selected number. Yoseloff teaches about the different probabilities associated with matching a one or more digits number chosen by a user with a random number generated by a

system (see column 8, lines 6-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a user would use the Walker system would select a product and would play a game to have the opportunity to win the product and to win the game and the product the user would choose a number and the system would generate a random number where the winning outcome would be determined if at least one digit of the user-chosen number matches at least one digit of the system generated random number, as taught by Yoseloff. This feature would give customers an incentive to visit the retailer site as customers would have the opportunity to win products by playing games without losing anything if the customer does not receive a winning outcome.

As per claim 5, Walker teaches:

The method of claim 3, wherein the probability of winning is different than one divided by ten raised to the power of the number of digits in the comparison number. However, Walker teaches that the probability of receiving a winning outcome varies with customers, where loyal customers would have a higher probability of receiving a winning outcome and winning the product than other customers that are not as loyal to the provider of the products (see paragraph 26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Walker would vary the probability of receiving a winning outcome based upon the customers loyalty to the retailer and, therefore, the probability of winning the game would be different than one calculated with probabilistic method such as one divided by ten raised to the power of the number of digits in the comparison number. Walker would

give a higher probability of winning the game to a loyal customer to thank him or her for

being a loyal customer, which would serve as an incentive to continue visiting the shop.

Claims 6, 11, 16, 26 and 28 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Walker et al (U.S. 2003/0054888) in view of Ghouri (US

2002/0082978) and further in view of Angles et al (U.S. 5,933,811).

As per claims 6, 11, 16, 26, 28 Walker teaches:

The method of claim 10, but fails to teach comprising providing the user with an

opportunity to increase the chances of winning on successive plays of the game by

performing a task for which a third party, such as a game provider, provides

compensation. However, Angles teaches a system where users are compensated for

viewing sponsors' advertisements (see column 16, lines 38-45). Therefore, it would

have been obvious to a person of ordinary skill in the art at the time the application was

made, to know that users of the Walker system would be compensated for the viewing

of selected sponsors' advertisements independently of the purchase of the advertised

product or service, as taught by Angles and these compensations would allow users to

play games to win the sponsors' advertise products, as taught by Walker.

Compensating users for viewing advertisements would be a good business decision as

this would increase the probability that users would view the sponsors' advertisements

and would play to win the advertise products, therefore increasing customer traffic and

customer loyalty.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker

et al (U.S. 2003/0054888) in view of Ghouri (US 2002/0082978) and further in view of

Angles et al (U.S. 5,933,811) and Yoseloff (US 6,331,143).

As per claim 30, Walker teaches:

The method for providing a user an opportunity to win a product or service of

claim 29 but fails to teach wherein the user can *increase the probability of winning* the

product or service by participating in an online survey for an advertising sponsor. It

would have been obvious to a person of ordinary skill in the art at the time the

application was made, to know that sponsors would compensate users for viewing the

sponsors' advertisements or for participating in the sponsors' online surveys. Sponsors

would compensate users by allowing the users to play games to win the sponsors'

products.

### Response to Arguments

4.      Applicant's arguments filed 03/30/2005 have been fully considered but they are

not persuasive. The Applicant argues that Walker does not teach that a user is

automatically provided with an option to play a game to win a selected product or

service without requesting the option. The Examiner answers that Applicant's figure 4

teaches that a user has to click the hyperlink "win it" to play to win a product, so said

user needs to make an request to play said game. Walker provisional (60/204,673)

page 2, summary teaches "that the customer may be able to select one or more

products (e.g., selecting on a web page, using a kiosk, scanning a barcode) that he

wants to win and may try to win the product(s) through various games including slot

machine, video poker, roulette, etc...A benefit of embodiments of the present invention

is that the excitement of gambling may be added to shopping, allowing the customer to

win any item of the customer's choice. Adding the excitement to shopping may be able

to increase sales for a particular retailer". Therefore, Walker teaches that a user makes

a request to win products and therefore, teaches the Applicant's claimed invention.

The Applicant argues that Walker does not teach automatically transmitting

electronic signals representing at least a first option for the user to play a game to win a

product without the user first making any payment. The Examiner answers that Walker

teaches in paragraph 130 "An alternate from of entry may also comprise signing one's

name, providing a fingerprint, or simply asking to play the game for free. Therefore,

Walker teaches at least a first option for the user to play a game to win a product

without the user first making any payment.

The Applicant argues that Walker does not teach the option of purchasing of a

product as an option to playing a game to win the prize.  The Examiner answers that

Walker teaches in paragraph 34 that "retail stores also include Websites in which

descriptions and visual representations of products for sale may be viewed by

customers and through which the customers may purchase one or more products for

sale". Therefore, Walker gives customers the option of being directed to a merchant's

website and purchase merchant's products, without the need to play a game to win said

product.

The Applicant argues that Walker does not teach "probability factor that varies

with the user's behavior occurring during a user session because Walker teaches that a

customer rating is associated with customer's purchasing history. The Examiner answers that Walker teaches that a customer may pay a fee in order to be associated with a particular rating (see paragraph 88). Therefore, if during a user session a customer pay a bigger fee, said customer based upon said behavior would receive a higher rating and a higher probability of receiving a winning outcome.

The Applicant argues that Walker does not teach the probability of winning on successive plays of the game increases with the value derived from the user's interaction with the system. The Examiner answers that Walker teaches in paragraph 89 that a probability may be determine based on a customer history or receiving winning outcomes stored in the customer database. Therefore, Walker teaches that the probability increase with the value derived from the user's interaction with the system.

### *Conclusion*

5.     **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 571-272-6724. The Right fax number of the Examiner is 571-273-6720.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Lastra
May 30, 2005

RETTA YEHDEGA
PRIMARY EXAMINER